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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,666	12/27/1999	KEITH C. THOMAS	98-1176	9062

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EXAMINER
KEMPER, MELANIE A

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/472,666	Applicant(s) THOMAS, KEITH C.
	Examiner M Kemper	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 July 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 9-12, 15-16, 18 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Freeman, "Eyemark Expands Virtually" Mediaweek, vol. 9, n. 7, pp.9(1) 2/15/99.

The article teaches the virtual product placement including selecting an original moving media content, editing the content, and inserting an identifiable representation of a product item (whole document).

3. Claims 9-12, 15-16, 18 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Battaglio, "'Virtual' Product Placing Gets Real in UPN" Hollywood Reporter, vol. 357, no. 4, p. 1, 3/25/99.

The article teaches the virtual product placement claimed.

4. Claim 6 is rejected under 35 U.S.C. 102(a) as being clearly anticipated by "Virtual Ads, Real Problems" Advertising Age, 5/24/99.

The article teaches the virtual product placement claimed including the selling of the placement of products which inherently includes the steps of dividing the time over which the content is released into a plurality of time slots since this step is necessary for determining "later airing".

5. Claims 9-18 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Sitnik.

Sitnik teaches a method for virtual product placement including selecting an original moving media content, editing the content, and inserting a product item in the content (see at least col. 2, lines 15-30, 40-55, col. 4, lines 5-35, col. 8, lines 35-55, col. 9, lines 10-67)

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Virtual Ads, Real Problems in view of Sitnik, patent number 6,160,570.

The article teaches a method of selling the placement of products, but does not teach selling based on geographic versions or the channel version (medium). Sitnik teaches product placement based on geographic versions and channel versions (see at least col. 4, lines 5-35, col. 8, lines 35-60, col. 9, lines 10 – col.

10, line 5). It would have been obvious to one having ordinary skill in the art at the time of the invention to have sold product placement in view of geographic regions and the channel type since these parameters would have been adopted for the intended use of reaching the target audience.

8. The declaration under 37 CFR section 1.131 filed on 7/24/02 under 37 CFR 1.131 has been considered but is ineffective to overcome the Virtual Ads, Real Problems, Advertising Age reference.

9. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Advertising Age reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The evidence submitted does not sufficiently show the methods of selling the placement of products as in claims 6-8. More specifically, dividing the time over which the content is released into a plurality of time slots, selling the placement of products in the content by time slot and placing the product into the contend released in the time slot is not shown. Also, the producing different versions of the content for different channels and selling by distribution channels is not shown. Also, the producing different versions of the content for different geographic areas and selling the placement of product in the content by geographic area is not shown. Also not shown is selecting

film, video stream, or video file (also where a specific type of game is not disclosed) as in claim 10. Also, none of the steps of claims 11-14 or 16-18 are shown. Also, the selecting an original moving media content is not shown since only a game is mentioned as the media.

10. Applicant's arguments filed 7/24/02 have been fully considered but they are not persuasive. The applicant relies upon the 131 declaration to overcome the rejections. As noted above, the declaration is insufficient to overcome the applied references.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ebisawa, patent number 5,946,664 teaches updating advertisements in a video game based on time (each new day) (see at least abstract).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

M. Kemper
Primary Examiner
Art Unit 3622

MK
October 20, 2002